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09/781,001	02/09/2001	Michael B. Stennicke	24193-00	6428

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EXAMINER

SHINGLES, KRISTIE D

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/781,001	Applicant(s) STENNICKE, MICHAEL B.	
	Examiner Kristie Shingles	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

*Applicant has amended the specification and drawings. Claims 1-9 are still pending.*

### ***Drawings***

1. The proposed drawing corrections and/or the proposed replacement-drawing sheets, filed September 7, 2004, have been accepted by the Examiner. The corrections to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **245** (of Figure 8e). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The proposed specification corrections of removing hyperlinks and/or other forms of browser-executable code, received on September 7, 2004, have been accepted.

### ***Response to Arguments***

4. **Per claims 1-5 and 7-9**, applicant's arguments filed on September 7, 2004 have been fully considered but they are not persuasive. The applicant argues that *Kenner et al* does not disclose preparing by the master of at least one tender for requesting media and submitting said tender to one or more of the plurality of catchers. However it is the examiner's position that *Kenner et al* teaches users building requests for multimedia data (e.g. video clips and text information) and transmitting the requests to a local storage and retrieval unit via the primary index manager (Abstract, Col.4 Lines 43-59 and Col.6 Lines 53-60). Therefore claims 1-5 and 7-9 remain rejected.

In response to applicant's argument that *Kenner et al* fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., what to do if a requested video does not currently exist within the database and ways to acquire data not already in the system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In response to applicant's argument that *Kenner et al*, does not describe a multimedia exchange, master, catcher or tender as claimed by Applicant; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

*Kenner et al* disclose the implementation of user/user terminals, user requests, index managers, primary index managers, local storage and retrieval units (SRU) and extended SRUs; which are capable of achieving the functions of the applicant's described multimedia exchange, master, catcher and tender (Col.7 Line 23-Col.10 Line 64 and Table 1).

*Kenner et al* disclose "the user establishing an account with the content provider...this account may be in the form of a subscription...When the user accesses subscribed-to content through the system, the account can be updated...[and] the user can be billed for usage..." The examiner's position is that billing for users' usage and access to the subscribed-to content is compensation for the content providers. Furthermore, exemplary embodiments of *Kenner et al*'s invention is directed to the real estate industry and "to video delivery over the Internet...applicable to a wide range of end uses (i.e., video clip retrieval system used for retail sales, dating services, travel services, and many other applications) where convenient access to corresponding audio-visual information would be useful" (Col.6 Lines 17-60).

*Kenner et al* further teach the Data Sequencing Interface (DSI) collecting the requested video clips and transmitting it to the local (SRU). The DSI manages the download of multimedia to the local SRU for storage. The examiner's position is that data is acquired and uploaded to the SRU in this format, which realizes the acquisition of the user's requested data to a localized/centralized device for downloading (Col.9 Lines 31-41 and Col.15 Line 59-Col.6 Line 61).

Furthermore, *Kenner et al* teach redirection when a requested video does not currently exist within the database of a local SRU, "...if one SRU cannot respond to the DSIs command...then the DSI simply retrieves the requested video clip from another location" (Col.15 Lines 53 and Col.16 Line 62-Col.17 Line 34).

5. **Per claim 6**, applicant's arguments filed on September 7, 2004 have been fully considered but they are not persuasive. The applicant argues that the combination *Kenner et al* and *Gunaseelan et al* does not disclose a multimedia exchange, master, catcher or tender as claimed by applicant. However it is the examiner's position that the combination of *Kenner et al* and *Gunaseelan et al* teaches the mode of exchanging data via the media server, an online/tertiary server as a catcher and the client as master. Furthermore, the limitation of claim 6 of directing in real-time by the master of the catcher in recording of said requested multimedia data, is taught by *Gunaseelan et al* with the provision of real-time streaming data from the source to the client (Col.3 Lines 2-65). Therefore claim 6 remains rejected.

In response to applicant's argument that *Gunaseelan et al* does not describe a multimedia exchange, master, catcher or tender as claimed by Applicant; the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of

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the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5 and 7-9 rejected under 35 U.S.C. 102(e) as being anticipated by *Kenner et al* (U.S. 5,956,716).

a. **Per claim 1**, *Kenner et al* teach a method of exchanging multimedia data among at least one master and a plurality of catchers over an electronic network of computing devices, the data being exchanged among a plurality of computing devices connected to the network, at least one of the plurality of computing devices performing functionality of an exchange, the method comprising the steps of:

- preparing by the master of at least one tender for requesting multimedia data of interest and submitting said tender to one or more of the plurality of catchers (**Fig.1 and col.4, lines 54-59; user builds request and submits it to a local storage and retrieval unit which then forwards the request to the primary index manager**);

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- acquiring and uploading by the one or more of the plurality of catchers said requested multimedia data to the exchange (**col.5, lines 8-16; the data sequencing interface collects the data and transmits it to the primary index manager and/or local storage and retrieval units**); and
- selecting by the master among said uploaded multimedia data by downloading said selected multimedia data from the exchange (**col.5, lines 17-20; from the local storage and retrieval units, the data is downloaded to the user's terminal**).

b. **Per claim 2, Kenner et al** teach the method of claim 1, further including a step of registering a plurality of users, said plurality of users being indexed as the master and/or as a catcher of said plurality of catchers (**col.24, lines 47-50 and col.21, lines 36-col.22, lines 1-60; the primary index manager maintains a database for registering user's subscriptions, preferences, and billing information in addition to maintaining information on the multimedia data stored in extended storage and retrieval units**).

c. **Per claim 3, Kenner et al** teach the method of claim 2, wherein the step of preparing and submitting said tender further including steps of:

- creating a data path over the network between the exchange and one of the plurality of computing devices used by the master (**col.4, lines 43-53 and col.8, lines 51-65; a datapath is implemented by virtue of the distributed computer system or network where users can communicate with the storage unit and database managers**) ;
- presenting said tender to said exchange by e-mail or posting on exchange's web page (**col.33, lines 38-57 and col.34, lines 29-39; by signing up for subscriptions on web pages the requests are thereby posted onto web page or the web server and subscriptions maintained and acknowledged at the primary index manager—using browser extensions to submit requests to the primary index manager also qualify as postings**); and
- selecting one or more of the plurality of catchers to whom said tender should be routed and routing said tender to the selected catchers (**col.4 lines 54-66, col.15 lines 24-30, and col.10 lines 10-21; the primary index manager and storage retrieval unit both route the request depending on where the data is located, if data is not available at the local storage and retrieval unit, then the primary index manager selects remote devices to ascertain the data**).

d. **Per claim 4, *Kenner et al* teach the method of claim 3, wherein the step of routing is performed by e-mailing said tender to the selected catcher or posting said tender in an electronic mail box of the selected catcher on a web page of the exchange (col.13, lines 35-54 and col.23, lines 66-col.24 lines 1-13; routing from the local storage and retrieval unit to the primary index manager involves passing information in the form of a virtual address that includes the internet address of the primary index manager recognizable and accepted by Netscape Navigator and other network browsers, which in turn functions as an electronic mailbox of the primary index manager).**

e. **Per claim 5, *Kenner et al* teach the method of claim 4, wherein said step of acquiring and uploading further includes the steps of:**

- **recording said multimedia data by the one or more catchers according to a request outlined in said tender prepared by said master (col.16, lines 44-61 and col.19, lines 22-30; once location of the requested data is found the storage and retrieval units download the data for storage and transmission to user terminals);**
- **creating thumbnails and descriptions for each unit of said multimedia data (col.18 lines 44-58, col.19 lines 40-48, col.28 lines 18-58, and col.31 lines 65-col.32 1-8, 38-50; the content provider provides textual descriptions and audio-visual segments of the requested data); and**
- **uploading said recorded multimedia data and said thumbnails and descriptions to said exchange (col.10, lines 40-57 and col.32, lines 64-col.33, lines 1-20; audio-visual segments and textual segments are stored in the primary index manager or the one of the local/remote storage and retrieval units).**

f. **Per claim 7, *Kenner et al* teach the method of claim 5, wherein the step of selecting further including the step of listing all the multimedia submitted in reply to said tender and all the multimedia that was uploaded to the exchange in the past and is equivalent to the**

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tender (col.5, lines 1-7 and col.23, lines 14-23; the primary index manager keeps track of a list of data requested by and available to a user).

g. Per claim 8, *Kenner et al* teach the method of claim 7, further including the step of setting a price for each unit of said submitted multimedia data by the plurality of catchers (col.33, lines 65-col.34, lines 1-15; prices can be set for data downloaded by the users from the primary index manager).

h. Per claim 9, *Kenner et al* teach the method of claim 8, further including the steps of:

- billing the master with said set price of said selected and downloaded multimedia data (col.6, lines 17-26; users are billed for the price of the downloaded data) and
- crediting the one or more catchers with the price of said selected submitted multimedia data (col.34, lines 16-28; subscription fees for requested data are credited to the data/content providers).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Kenner et al* and further in view of *Gunaseelan et al* (U.S. 6,601,136).

a. Whereas, *Kenner et al* teach from above on the method of claim 4, wherein said step of acquiring and uploading further includes the steps of: recording said multimedia data by the one or more catchers according to a request outlined in said tender prepared by said master; creating thumbnails and descriptions for each unit of said multimedia data; and uploading said recorded multimedia data and said thumbnails and descriptions to said exchange—*Kenner et al* fail to explicitly teach on the method of claim 5, wherein said step of recording further including the step of directing in real-time by the master of the catcher in recording of said requested multimedia data. However, *Gunaseelan et al* teach the method of claim 5 wherein the step of recording further includes the step of directing in real-time streaming digital media with a live-encoded source and transmitted to user terminals (col.3, lines 2-10 and col.6, lines 14-29).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to allow real-time directing/playback of digital media for the purpose of providing instant media and data access to users. One skilled in the art would have been motivated to generate the claimed invention in order to enable fast media transmission.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. *Graham* (USPN 6,732,183) discloses a computer system providing streaming video and audio media to a plurality of clients over a network.
- b. *Stumm* (USPN 5,768,528) discloses a method for operating a server system adapted to provide information files to a plurality of subscribers over a communication network, such as the Internet.
- c. *Ottesen et al* (USPN 5,930,493) disclose a multimedia server system and method for communicating multimedia information.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles  
Examiner  
Art Unit 2141

kds



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SUPERVISORY PATENT EXAMINER